

II. RESPONSE TO OFFICE ACTION

A. Status of the Claims

Claims 1-63 were pending at the time of the Action. Claim 2 has been canceled, and claims 1, 3-5, 7, 12, 15, 20, 21, 32, 48, 49 and 54 have been amended in the Amendment contained herein. New claim 64 has been added by amendment. No new matter is added by the amendments or the new claim. Therefore, claims 1 and 3-64 are pending after entry of the Amendment.

B. Rejections under 35 USC § 102(b)

Claims 1-8, 10-11, 22-26, 48-53 and 55-61 are rejected under 35 USC § 102(b) as anticipated by Lim *et al.* (US 6,461,391). The Action alleges that Lim *et al.* teaches a hair dyeing composition comprising the cationic direct dyes as claimed and an oxidation base of cationic tertiary para-phenylenediamine having a formula (I), which has all the limitations of claimed formula (I). Applicants traverse.

The instant invention claims a composition that must comprise a cationic tertiary para-phenylenediamine comprising a pyrrolidine ring and a cationic direct dye comprising at least one heterocyclic group. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Action claims that Lim *et al.* recites direct cationic dyes as claimed, citing to col. 7, lines 18-54. The cited material is a laundry list of “certain other dye ingredients.” Included in this list are a few cationic direct dyes, although they are disclosed only as “direct dyes,” not as “cationic dyes,” by name or by structure, and thus the cationic nature of the dyes is

only inherently disclosed. Of the few cationic direct dyes, there is at least one with a heterocyclic group, although most do not contain this required element. Again, due to the lack of any express disclosure in regard to identification or structure of the required element, this is an inherent disclosure. As stated by the *Manual of Patent Examining Procedure* (M.P.E.P.) § 2112.IV (8th Ed. Inc. Rev. No. 1):

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

In regard to the teachings of Lim *et al.*, the “certain other dye ingredients” are optional additional ingredients. Thus they are not necessarily combined with the oxidant dyes of Lim *et al.* Indeed, no such combination is claimed or specifically exemplified. Thus, lacking any specific disclosure of the required elements of a cationic direct dye with at least one heterocyclic group, the inherent disclosure of one such dye as one of a long list of optional ingredients fails to reach the required standard, *i.e.*, that the reference teaches a composition that necessarily has a cationic tertiary para-phenylenediamine comprising a pyrrolidine ring and a cationic direct dye comprising at least one heterocyclic group. Applicants respectfully assert that the disclosure of Lim *et al.* is legally insufficient to anticipate the rejected claims.

In light of the forgoing, the rejection of claims 1-8, 10-11, 22-26, 48-53 and 55-61 as anticipated by Lim *et al.* should be withdrawn.

C. Rejections under 35 USC § 103(a)

1. *The standard for establishing a prima facie case of obviousness.*

It is well settled that “[t]he examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under *no* obligation to submit evidence of nonobviousness.” M.P.E.P. § 2142 (emphasis added).

To establish a *prima facie* case of obviousness, the Action must show: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a reasonable expectation of success; and (3) the prior art reference teaches or suggests all of the claim limitations. *See In re Vaeck*, 947 F.2d 488, (Fed Cir. 1991). With respect to element (1), “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. at § 2143.01. If any one of the three elements is missing, an obviousness rejection cannot be maintained.

2. *The rejections of claims 54 and 62-63 over Lim et al. are improper.*

Claims 54 and 62-63 are rejected as obvious over Lim *et al.* The Action alleges that Lim *et al.* teaches: a hair dyeing composition comprising cationic direct dyes; an oxidation base of cationic tertiary para-phenylenediamine having a formula (I), which is identical to claimed formula (I); other primary intermediates (oxidation bases) such as para-phenylenediamines and couplers presented in the composition in the amount of 0.001 to 10%; and that the oxidation dyeing composition is mixed with an oxidizing agent immediately prior to application to the hair. The Action acknowledges that Lim *et al.* does not teach the percentage amounts of the additional

oxidation bases used in the composition nor a multi-compartment device. However, the Action goes on to allege that it would have been obvious to optimize the amounts of oxidation bases in the dyeing composition and that as the oxidation composition is mixed with the oxidizing agent at the time of use, implying separate containers, a person of ordinary skill in the art would have been motivated to use a multi-compartment container. Applicants respectfully traverse.

In regard to cationic direct dyes, the few that Lim *et al.* recites are inherently disclosed in a laundry list of “certain other dyes ingredients.” Absolutely nothing in Lim *et al.* suggests the desirability of the particular combination of a direct cationic dye with at least one heterocyclic group and a cationic oxidant base, as required by the present invention. The Action provides no particular findings as to why one of skill in the art would recognize the desirability to make this particular combination of elements. In regard to the motivation to use a multi-compartment container, Applicants assume that the conclusory statements as to motivation imply that “common knowledge in the art” is the asserted source of motivation to use a multi-compartment device for holding the dyeing composition. Applicants respectfully assert that the support for such motivation is inadequate. As stated by the Federal Circuit: “[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The Court further stated that “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” but it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697. As the Board is so limited, so is the Examiner. The federal Circuit has also held that:

[C]ommon knowledge and common sense on which the Board relied in rejecting [Applicant's] application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation... The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The Action only provides conclusory statements as to motivation and is apparently imposing the expertise of the Examiner as to what is common knowledge. Such statements in the Action are specifically held not to amount to "substantial evidence," and as such are insufficient to establish a motivation to modify the teachings of Lim *et al.* If the Examiner is going to continue to rely on an allegation that common knowledge supports these rejections, he is requested to support this assertion with either a citation to prior art or an Examiner's affidavit, pursuant to the requirements of M.P.E.P. 2144.03.

In light of the foregoing, the rejections of claims 54 and 62-63 as obvious over Lim *et al.* should be reconsidered and withdrawn.

3. *The rejections of claims 27-29 over Lim *et al.* in view of Vidal *et al.* are improper.*

Claims 27-29 are rejected as obvious over Lim *et al.* in view of Vidal *et al.* (FR 2882696/US 2004/0187225 A1). The Action alleges that Lim *et al.* teaches a hair dyeing composition comprising the cationic direct dyes as claimed and an oxidation base of cationic tertiary para-phenylenediamine having a formula (I), that is identical to claimed formula (I). The rejected claims are stated to differ from Lim *et al.*, by reciting specific cationic direct dyes. The Action states that Vidal *et al.* teaches a composition comprising heterocyclic dicationic diazo dyes that have all the limitations of the claimed formula (Va). A reasonable expectation of success and motivation is stated to be that the dyes of Videl *et al.* would be expected to have similar properties to those claimed in Lim *et al.* Applicants traverse.

The Action provides no findings as to why one of skill in the art would be motivated by the inherent disclosure in Lim *et al.*, of a direct cationic dye with a heterocyclic group hidden in a list of numerous other dye ingredients, to select the particular cationic dyes of Vidal *et al.* for combination with the particular cationic tertiary para-phenylenediamine oxidation bases of Lim *et al.* There is absolutely **nothing** in Lim *et al.* that indicates the particular desirability of combining cationic direct dyes comprising a heterocyclic group dyes with the cationic oxidant bases of the present invention. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998), (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with the knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”). As stated in M.P.E.P. § 2143.01: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The Action has cited to statements of the general suitability for use of the cationic heterocyclic dyes of Vidal *et al.*, but has not provided evidence as to the particular desirability of the combination with the oxidation bases of Lim *et al.* that would have motivated one of skill in the art to combine these specific references as is required by current case law. If the Examiner is relying in any way on an assertion that common knowledge supports this rejection, he is requested to support this assertion with either a citation to prior art or an Examiner’s affidavit, pursuant to the requirements of M.P.E.P. 2144.03.

Applicants respectfully assert that the Action has failed to establish a *prima facie* case of obviousness, and thus requests that the rejection of claims 27-29 as being obvious over Lim *et al.* in view of Vidal *et al.* be reconsidered and withdrawn.

4. *The rejections of claims 32-33 over Lim et al. in view of Vidal et al. and further in view Mockli are improper.*

Claims 32-33 stand rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Mockli (US 5,708,151). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejection recited above. The Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vc) or (Vd) as claimed. Mockli is stated to teach dicationic dyes that fall within the scope of claims 32 and 33 and that Mockli “clearly teaches that the use of cationic diazo dyes in the dyeing composition provide hair with shades having good fastness properties,” thereby providing the motivation and the reasonable expectation of success for modifying the teachings of Lim *et al.* and Vidal *et al.* with the dyes of Mockli. Applicants respectfully traverse.

The combination of Lim *et al.* and Vidal *et al.* has the same infirmities as described above, and the further combination of Mockli does not cure, but further exacerbates, these deficiencies. This reference does **not** “clearly teach that the use” of the dicationic dyes of formula (Vc) or (Vd) as claimed “provide hair with shades having good fastness properties.” If the cite provided in the Action, *i.e.*, Mockli col. 6, lines 47-48, is examined, it is clear that this statement is made in reference to intermediates represented by compounds of formula (8), a proposition further reiterated in the claims and examples. In that a similar statement is not made in regard to dicationic dyes that have the limitations of the dicationic dyes of formula (Vc) or (Vd) as claimed, it would appear to teach away from using these compounds for hair. Thus, the evidence proffered in the Action in support of the alleged motivation and reasonable expectation for success is quite simply incorrect. Thus, the attempted combination with Mockli only further compounds the deficiencies of the combination of Lim *et al.* and Vidal *et al.* as detailed above.

In light of the foregoing, Applicants respectfully requests that the rejection of claims 32 and 33 as being obvious over Lim *et al.* in view of Vidal *et al.* and further in view of Mockli be reconsidered and withdrawn.

5. *The rejections of claims 34-35 over Lim et al. in view of Vidal et al. and further in view of Kaser are improper.*

Claims 34 and 35 stand rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Kaser (US 5,674,299). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejections recited above. The Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Ve) as claimed. Kaser is stated to teach the dicationic dyes of formula (Ve), and that alone is apparently sufficient to provide both motivation and a reasonable expectation of success. Applicants respectfully traverse.

The combination of Lim *et al.* and Vidal *et al.*, has the same infirmities as described above, and the further combination of Kaser does not rectify the inadequacies, especially as there is no appropriate basis proffered to support the combination of this reference. The teachings of Kaser are directed to basic dyes suitable for dyeing paper, and hair is **not** mentioned. Applicants take the rote and conclusory statements of the Action in regard to motivation and reasonable expectation of success and the absence of **any** supporting particular findings as an implicit acknowledgment of the absence of such elements. The Action provides no reasonable rationale as to why one of skill in the art would combine dicationic direct dyes taught for dyeing paper with teachings for dyeing hair that does not teach any direct cationic dyes. Applicants respectfully assert that the Action fails to provide a *prima facie* case of obviousness. If the Examiner is relying in any way on an assertion that common knowledge supports this rejection, he is requested to support this assertion with either a citation to prior art or an Examiner's affidavit, pursuant to the requirements of M.P.E.P. 2144.03.

In light of the foregoing, Applicants respectfully requests that the rejection of claims 34 and 35 as being obvious over Lim *et al.* in view of Vidal *et al.* and further in view of Kaser be reconsidered and withdrawn.

6. *The rejection of claim 36 over Lim et al. in view of Vidal et al. and further in view of Vidal et al. is improper.*

Claim 36 stands rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Vidal *et al.* (FR 2822698 B1/US20040093676). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejections recited above. The Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vf) and (Vg) as claimed. Vidal *et al.*, US '676 is stated to teach a dicationic dye with all the limitations of formula (Vf) as claimed. In that Lim *et al.* teaches the use of direct dyes, one of ordinary skill in the art would have allegedly been motivated to modify the teaching of Lim *et al.*, with the dicationic dyes of Vidal *et al.*, US '676 with a reasonable expectation of success. Applicants respectfully traverse.

The combination of Lim *et al.* and Vidal *et al.*, has the same infirmities as described above, and the further combination of Vidal *et al.* US '676, does not rectify the inadequacies. Lim *et al.* simply does not teach particular desirability of the combination with cationic dyes. The Action provides no motivation as to the specific desirability of modifying the teachings of Lim *et al.* with the dicationic dyes of Vidal *et al.* US '676. That the references can be combined is not enough. Under the rationale of the Action, *i.e.*, that they would work, **any and all** suitable direct dye could be combined with the teachings of Lim *et al.* Such a facile combination of references is not consonant with current case law. The Action has to answer the question: What would motivate one of skill in the art, having no knowledge of the instant invention, to combine the specific dicationic dyes of Vidal *et al.*, US '676, with the teachings of Lim *et al.*, considering

that the latter reference does not disclose any direct cationic dyes? The failure to provide particular findings as to this point results in a failure to proffer a *prima facie* case of obviousness, and the rejection must fail. If the Examiner is relying in any way on an assertion that common knowledge supports this rejection, he is requested to support this assertion with either a citation to prior art or an Examiner's affidavit, pursuant to the requirements of M.P.E.P. 2144.03.

In light of the foregoing, Applicants respectfully requests that the rejection of claim 36 as being obvious over Lim *et al.* in view of Vidal *et al.* and further in view of Vidal *et al.*, US '676, be reconsidered and withdrawn.

7. *The rejection of claim 37 over Lim et al. in view of Vidal et al. and further in view of Vidal et al. is improper.*

Claim 37 stands rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Vidal *et al.* (WO 02/078659/US20040093675). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejections recited above. Although the Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vf) and (Vg) as claimed, Applicants understand the Action to have meant that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vh) as claimed in claim 37. Vidal *et al.* US '675, is stated to teach dicationic monazo dyes with all the limitations of formula (Vh). Applicants respectfully traverse.

The grounds of the rejection in the Action are stated almost verbatim as for the prior rejection. Thus, the prior response is also applicable to this rejection, in that a *prima facie* case of obviousness has not been established. The Action is just swapping out references to provide an appropriate dye with the addition of conclusory statements as to motivation and reasonable expectation of success. This does not establish a *prima facie* case of obviousness. In light of the foregoing, Applicants respectfully request that the rejection of claim 37 as being obvious over

Lim *et al.* in view of Vidal *et al.* and further in view of Vidal *et al.*, US ‘675, be reconsidered and withdrawn.

8. *The rejection of claim 38 over Lim et al. in view of Vidal et al. and further in view of Vidal et al. is improper.*

Claim 38 stands rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Vidal *et al.* (WO 02/078658/US20040168263). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejections recited above. Although the Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vf) and (Vg) as claimed, Applicants understand the Action to have meant that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vi) as claimed in claim 38. Vidal US ‘263 is stated to teach dicationic monazo dyes with all the limitations of formula (Vi). Applicants respectfully traverse.

The grounds of the rejection in the Action are stated almost verbatim as for the prior rejection. Thus, the prior response is also applicable to this rejection, in that a *prima facie* case of obviousness has not been established. The Action is again just “cherry picking” among references to provide an appropriate dye with the addition of conclusory statements as to motivation and reasonable expectation of success. This does not establish a *prima facie* case of obviousness. In light of the foregoing, Applicants respectfully requests that the rejection of claim 38 as being obvious over Lim *et al.* in view of Vidal *et al.* and further in view of Vidal *et al.* US ‘263, be reconsidered and withdrawn.

9. *The rejection of claim 39 over Lim et al. in view of Vidal et al. and further in view of Vidal et al. is improper.*

Claim 38 stands rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Vidal *et al.* (WO 02/078657/US20040123400). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejections recited above. Although the

Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vf) and (Vg) as claimed, Applicants understand the Action to have meant that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vj) as claimed in claim 39. Vidal US '400 is stated to teach dicationic monazo dyes with all the limitations of formula (Vi). Applicants respectfully traverse.

The grounds of the rejection in the Action are stated almost verbatim as for the prior rejection. Thus, the prior response is also applicable to this rejection, in that a *prima facie* case of obviousness has not been established. The Action is verifying its use of hindsight-based obviousness analysis by the substitution of one reference for another to provide an appropriate dye, with the addition of conclusory statements as to motivation and reasonable expectation of success. This does not establish a *prima facie* case of obviousness. In light of the foregoing, Applicants respectfully requests that the rejection of claim 39 as being obvious over Lim *et al.* in view of Vidal *et al.* and further in view of Vidal *et al.* US '400, be reconsidered and withdrawn.

10. *The rejections of claims 40-41 over Lim et al. in view of Vidal et al. and further in view of Vidal et al. are improper.*

Claims 40 and 41 stand rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Vidal *et al.* (US 20030106169). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejections recited above. The Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dicationic dyes of formula (Vk) as claimed. Vidal US '169, is stated to teach dicationic dyes with all the limitations of formula (Vi). Applicants respectfully traverse.

The grounds of the rejection in the Action are stated almost verbatim as for the prior rejection. Thus, the prior response is also applicable to this rejection, in that a *prima facie* case of obviousness has not been established. The Action is again just exchanging the references to

provide an appropriate dye with the addition of conclusory statements as to motivation and reasonable expectation of success. This does not establish a *prima facie* case of obviousness. In addition, Applicants note the Vidal US '169 could only be cited as prior art under to 35 USC § 102(e). While vigorously denying that a *prima facie* case of obviousness has been established, Vidal *et al.* US '169, is, as per the following Statement of Common Ownership, removed as a reference under 35 USC § 102(e) for the purposes of rejections under 35 USC § 103(a). Thus, in light of the foregoing and the following statements, Applicants respectfully request that the rejection of claim 39 as being obvious over Lim *et al.* in view of Vidal *et al.* and further in view of Vidal *et al.* US '400, be reconsidered and withdrawn.

a. Statement of Common Ownership

US 20030106169 and the instant application, USSN 10/735,259, were owned by L'Oreal SA, at the time of the invention of USSN 10/735,259 was made.

11. The rejections of claims 42-46 over Lim et al. in view of Vidal et al. and further in view of Rondeau et al. are improper.

Claims 42–46 stand rejected as being obvious over Lim *et al.* in view of Vidal *et al.*, and further in view of Rondeau *et al.*, (US 6,432,146). The stated teachings of Lim *et al.* and Vidal *et al.* were as in the prior obviousness rejections recited above. The Action acknowledges that Lim *et al.* and Vidal *et al.* do not teach the dyes of formulas (VI), (Vm), (Vn), (Vo and (Vp) nor cationic direct dyes comprising at least one imidazolium or pyridinium ring substituted with one or more alkyl groups. Rondeau *et al.* is stated to teach dicationic dyes with all the limitations of formulas (VI), (Vm), (Vn), (Vo and (Vp) and cationic direct dyes comprising at least one imidazolium or pyridinium ring substituted with one or more alkyl group. Applicants traverse.

The grounds of the rejection in the Action are stated almost verbatim as for the prior rejection. Thus, the prior response is also applicable to this rejection, in that a *prima facie* case

of obviousness has not been established. The Action is just swapping out references to provide an appropriate dye with the addition of conclusory statements as to motivation and reasonable expectation of success. This does not establish a *prima facie* case of obviousness.

In light of the foregoing, Applicants respectfully request that the rejection of claim 39 as being obvious over Lim *et al.* in view of Vidal *et al.* and further in view of Rondeau *et al.* be reconsidered and withdrawn.

12. *The rejection of claim 47 over Lim et al. in view of Kawai et al. is improper.*

Claim 47 stands rejected as being obvious over Lim *et al.* in view of Kawai *et al.* (US 20020144356). The stated teaching of Lim *et al.* is as in the prior obviousness rejections recited above. Although the Action acknowledges that Lim *et al.* does not teach a monocationic monoazo direct dye chosen from Basic Red 22, Basic Red 51, Basic Orange 31 and Basic Yellow 87, Kawai *et al.* is stated to teach basic Red 22 and Basic Yellow 87. Applicants respectfully traverse.

Yet again, the basis of the rejection is that the reference can be combined, although no reasonable rationale for the combination is proffered by the Action. Kawai *et al.* teaches literally dozens of dye for use in semipermanent dyeing compositions without oxidant bases. The Action does not provide particular findings as to why one of skill in the art would choose two particular cationic dyes out of the many dyes recited in Kawai *et al.*, and combine them with teachings of the use of particular quaternized pyrrolidine para-phenylenediamine oxidant dyes that does not mention the use of cationic direct dyes. This combination can only be considered to be specious. This rejection clearly does not establish a *prima facie* case of obviousness.

In light of the foregoing, Applicants respectfully request that the rejection of claim 47 as being obvious over Lim *et al.* in view of Kawai *et al.* be reconsidered and withdrawn.

C. The Objections to Claims 9, 12-21, 30 and 31 are Moot

Claims 9, 11-12, 30 and 31 are objected to as, while otherwise being allowable, depending upon a rejected base claim. These objections are rendered moot because the base claims from which these claims depend are allowable for the reasons set forth above.

However, Applicants have added new claim 64 that incorporates formula (III) and (IV) as limitations as well as formula (II), wherein formula (II) is limited by a proviso such that R₄ cannot be an alkyl group when the linker D is a covalent bond. Applicants believe that this renders the cationic tertiary para-phenylenediamine compounds of formula (I) distinct from those disclosed by Lim, *et al.* and that claim 64 is allowable independent of the above arguments.

D. Conclusion

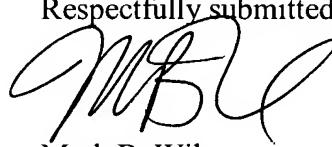
Applicants believe that the present document is a full and complete response to the Office Action dated November 17, 2004. The present case is in condition for allowance, and such favorable action is respectfully requested.

III. REQUEST FOR EXTENSION OF TIME

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of three months to and including May 17, 2005, in which to respond to the Office Action dated November 17, 2004. Pursuant to 37 C.F.R. § 1.17(a)(2), a check in the amount of \$1,020.00 is enclosed, which is the fee for a three-month extension of time for a large entity. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/LORE:014US.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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